

REMARKS

Claims 1-42 are pending. Claims 43-63 have been cancelled without prejudice herein.

The cancellation without prejudice of claims 54-56 and 59-62 obviates the Examiner's concerns regarding these claims being substantial duplicates of other pending claims.

Claim 1 has been rejected as being unpatentable over Hochgraf in view of Leonard and Carroll. This rejection is respectfully traversed.

The Examiner acknowledges, at p. 5 of the office action, that Hochgraf does not teach the use of vacuum for detecting holes (or, Applicant might add, for any purpose). The Examiner asserts that Leonard remedies this deficiency.

While Applicant agrees that Leonard teaches the use of vacuum to detect pinholes, the artisan would not have combined the teachings of Leonard with those of Hochgraf.

Hochgraf is concerned with surface defects (see, e.g., Abstract, col. 1, lines 7-9, 11-12, claim 1, etc.). While Hochgraf does mention tears and through-holes as examples of possible defects, he does not care whether a defect extends through the thickness of the web or not. He is equally disturbed by the presence of defects that do not extend through the web, e.g., abrasions, pinch marks, staining, impurities, etc. In fact, the artisan would likely have perceived Hochgraf as being uninterested in very small holes, the presence of which does not affect the surface quality of the web. Hochgraf's concern with surface defects no doubt reflects the concerns of the assignee, Eastman Kodak, a producer of photographic products. Many such products include a web coated with an emulsion coating which must be extremely uniform in order to provide a quality image, thus requiring the web to have a mirror-smooth surface.

Surface defects can be effectively detected by visual inspection systems, such as the illumination system described by Hochgraf. Thus, the artisan would not have been motivated to apply a vacuum, as described by Leonard. Such a modification of the Hochgraf system would have merely added cost, without enhancing the effectiveness of the system in accomplishing Hochgraf's objectives.

The Examiner asserts, at p. 8 of the office action, that "having such a redundancy in Hochgraf to aid in detecting holes in webs will help insure that the moving web is free of

pinholes that might negatively affect the web's performance." For Hochgraf, however, a defect that will affect the performance of the web is a defect that mars the surface of the web. Pinholes would not necessarily fall into this category, while serious surface defects such as staining and abrasion could not be detected using vacuum.

Thus, only the guidance provided by *Applicant's own specification* would have led the artisan to make such a modification. It is axiomatic that Applicant's specification cannot be used as a blueprint to reconstruct the invention from selected teachings in the prior art. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985).

Carroll, cited to provide a teaching of testing for holes with a liquid other than ammonia, does not remedy the deficiencies of Hochgraf and Leonard, discussed above. Carroll does not supply a motivation that would have led the artisan to combine the teachings of Hochgraf and Leonard as proposed by the Examiner.

In view of the above remarks, Applicant respectfully requests that this rejection be withdrawn.

Particular dependent claims have been rejected as unpatentable over the references discussed above further combined with other secondary references. These references do not supply what is lacking in the references discussed above, and thus Applicant respectfully submits that claim 1 and the claims that depend therefrom are patentable over these references for at least the reasons discussed above.

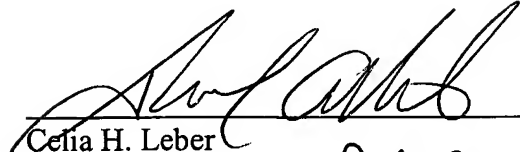
Enclosed is a \$55.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 10526-007001.

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Respectfully submitted,

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